

Remarks

Reconsideration of this Application is respectfully requested.

Claims 13, 16, 17, 52-59, and 69-71 are pending in the application, with claims 13 and 71 being the independent claims. Claims 1-12, 14, 15, 18-51, and 60-68 were previously canceled. No new matter has been added.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Information Disclosure Statement

In section 3 of the Office Action, the Examiner alleged that the Tenth Supplemental Information Disclosure Statement filed April 7, 2006 does not comply with 37 CFR 1.98(a)(2). As such, the Examiner merely states a rule, but does not indicate how Applicants (or which references) have violated the rule. Applicants respectfully request clarification as to why the Examiner believes that the Tenth Supplemental Information Disclosure Statement filed April 7, 2006 does not comply with 37 CFR 1.98(a)(2).

Rejections under 35 U.S.C. § 103

Claims 13, 17, 58, 59, 70, and 71

In section 5 of the Office Action, claims 13, 17, 58, 59, 70, and 71 were rejected as being unpatentable over U.S. Pub. No. 2002/0079572 to Kahn *et al.* (hereinafter

"Kahn") in view of U.S. Patent No. 6,583,513 to Utagikar *et al.* (hereinafter "Utagikar"). Applicants respectfully traverse this rejection.

The Examiner fails to establish a *prima facie* case of obviousness for at least the reason that the Examiner fails to show where the cited art contains the alleged suggestion or motivation to combine Kahn and Utagikar. To establish obviousness based on a combination of references, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000); M.P.E.P. § 2143.

The Examiner relies on plastic substrate 302 in Figure 11 of Kahn to allegedly show the substrate of Applicants' claim 13. The Examiner concedes that Kahn fails to disclose a) a ring shaped stiffener and b) a conductive pad on the first surface of the substrate. Instead, the Examiner relies on Utagikar to allegedly show these features. The Examiner explains, "It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the semiconductor device of Kahn to include a ring shaped stiffener ... as disclosed in Utagikar because it aids in strengthening the substrate." Office Action, pp. 3-4.

However, Applicants assert that the plastic substrate 302 of Kahn is rigid and therefore does not need to be strengthened by a stiffener or otherwise. Thus, it clearly would not have been obvious to one having ordinary skill in the art at the time the invention was made to modify the semiconductor device of Kahn to include the stiffener of Utagikar. In fact, Applicants assert that Kahn *teaches away* from combination with Utagikar by describing a rigid substrate in the absence of a stiffener. For example,

adding a ring shaped stiffener to an IC package when not needed would undesirably raise package costs and increase package complexity, and would thus presumably be avoided.

For at least these reasons, there is no suggestion or motivation to combine Kahn and Utagikar, from the prior art, to achieve the subject matter of independent claim 13.

Moreover, claims 17, 58, 59, and 70, which depend from independent claim 13, also distinguish over Kahn and Utagikar, alone or in any combination, for at least reasons similar to those set forth above with respect to independent claim 13, and further in view of their own respective features.

Furthermore, independent claim 71 also distinguishes over Kahn and Utagikar, alone or in any combination, for at least reasons similar to those set forth above with respect to independent claim 13, and further in view of its own features.

Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 13, 17, 58, 59, 70, and 71.

Claims 16 and 52-57

In section 6 of the Office Action, claims 16 and 52-57 were rejected as being unpatentable over Kahn in view of Utagikar and U.S. Patent No. 5,744,863 to Culnane *et al.* (hereinafter "Culnane"). Applicants respectfully traverse this rejection.

Claims 16 and 52-57 also distinguish over Kahn and Utagikar, alone or in any combination, for at least reasons similar to those set forth above with respect to independent claim 13, and further in view of their own respective features. Moreover, Culnane does not supply the deficiencies of Kahn and Utagikar. Thus, Applicants assert that claims 16 and 52-57 are patentable over Kahn, Utagikar, and Culnane, alone or in any combination.

Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 16 and 52-57.

Claim 69

In section 7 of the Office Action, claim 69 was rejected as being unpatentable over Kahn in view of Utagikar, Culnane, and U.S. Patent No. 5,903,052 to Chen *et al.* (hereinafter "Chen"). Applicants respectfully traverse this rejection.

Claim 69 also distinguishes over Kahn and Utagikar, alone or in any combination, for at least reasons similar to those set forth above with respect to independent claim 13, and further in view of their own respective features. Moreover, Culnane and Chen do not supply the deficiencies of Kahn and Utagikar. Thus, Applicants assert that claim 69 is patentable over Kahn, Utagikar, Culnane, and Chen, alone or in any combination.

Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 69.

Double Patenting Rejections

In sections 9-11 of the Office Action claims 13, 16, 17, 52-59, and 69-71 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 38, 50, and 51 of co-pending Application No. 10/939,075 in view of Kahn. Applicants respectfully request that these rejections be held in abeyance until allowable subject matter is indicated.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Bryan S. Wade
Attorney for Applicant
Registration No. 58,228

Date: 10/2/06

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600